

The opinion in support of the decision being entered today was **not** written
for publication and is **not** binding precedent of the Board.

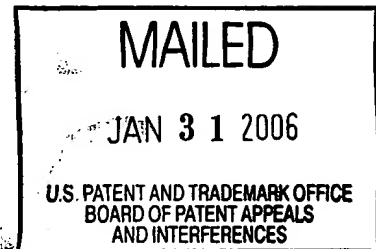
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

**Ex parte DWIP N. BANERJEE, RABINDRANATH DUTTA, and
KRISHNA YELLEPEDDY**

Appeal No. 2005-2373
Application No. 09/895,095

ON BRIEF



Before HAIRSTON, JERRY SMITH, and DIXON, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-35,
which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

Appellants' invention relates to a digital rights management. A copy of representative claim 1 under appeal is set forth below.

1. A method of augmenting digital rights management, the method comprising:

associating a first field with an electronic property, wherein the first field identifies a current owner of the electronic property; and

associating a second field with the electronic property, wherein the second field includes a list of owners having an order according to a historical order of transfer of rights to the electronic property between a plurality of previous owners; and

wherein access control software allows access to the electronic property only upon verification that a user satisfies specified requirements for access, and wherein the specified requirements include the user being listed as the current owner in the first field.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Christiano
Ginter et al. (Ginter)

5,671,412
5,892,900

Sep. 23, 1997
Apr. 06, 1999

Claims 1-35 stand rejected under 35. U.S.C. § 103(a) as being unpatentable over Ginter and Christiano.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the answer (mailed Mar. 8, 2005) for the examiner's reasoning in support of the rejection, and to the brief (filed Dec. 13, 2004) and reply brief (filed Apr. 25, 2005) for appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Only those arguments actually made by appellants have been considered in this decision. Arguments that appellants could have made but chose not to make in the brief have not been considered. We deem such arguments to be waived by appellants [see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)].

35 U.S.C. § 103

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a ***prima facie*** case of obviousness. **See In re Rijckaert**, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A ***prima facie*** case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. **See In re Lintner**, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is ***prima facie*** obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. **See In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on 35 U.S.C. § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. **See In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against

employing hindsight by using the appellants disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. **See, e.g., Grain Processing Corp. v. American Maize-Prods. Co.**, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, “the [E]xaminer can satisfy the burden of showing obviousness of the combination ‘only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.’” **In re Lee**, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing **In re Fritch**, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). “Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’” **In re Dembiczak**, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). “Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact.” **Dembiczak**, 175 F.3d at 999-1000, 50 USPQ2d at 1617, citing **McElmurry v. Arkansas Power & Light Co.**, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. “[T]he name of the game is the claim.” **In re Hiniker Co.**, 150 F.3d

1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations as recited in independent claim 1. We find that independent claim 1 sets forth “associating a second field with the electronic property, wherein the second field includes a list of owners having an order according to a historical order of transfer of rights to the electronic property between a plurality of previous owners.” Appellants argue that neither Ginter nor Christiano teaches or suggest associating a second field with an electronic property and having a historical order of transfer of rights. (Brief at pages 9-10.) The examiner admits at page 3 of the answer that Ginter does not keep a record of prior owners and relies upon Christiano at columns 3-5. From our review of Christiano, we find no teaching or suggestion of maintaining “a list of owners having an order according to a historical order of transfer of rights to the electronic property between a plurality of previous owners” as recited in independent claim 1. The examiner maintains that the second step of independent claim 1 pertaining to the historical list of owners is nonfunctional descriptive material and concludes that the nonfunctional descriptive material will not distinguish the claimed invention from the prior art. (Answer at pages 7-8.) Here, the examiner analyzes the claimed invention with respect to a determination of the presence of statutory subject matter and then seem to discount those limitations pertaining to nonfunctional descriptive material. While we agree with the examiner that the type and content of the data may not

necessarily distinguish the nonfunctional descriptive data from other nonfunctional data, we do not find that the examiner has established that the license management system of Christiano stores or associates the prior owner data with the electronic property as required by the instant claimed invention. (Reply brief at page, 9-10.) The examiner maintains that “ Christiano principally teaches the use of a license management system and method wherein the license server creates a license database after receiving license data and/or package certificates, including a computer system's node, address, serial number, licensee user name, or other identifier information to examine ‘license records to determine whether a requesting computer system should be allowed access to the digital property (column 6, line 64-column 7, line 46; column 8, lines 30-67; column 9, lines 9-64).’ Therefore, since Christiano's license server stores identifiers with respect to digital property rights for purposes of access or license violation notification, such transfer of rights or “list of owners” as defined by Appellant is recorded regardless of whether the license is active (current owner) and allowed access or inactive (previous owner) and refused the right to use of the digital property.

Here, the examiner states that the server stores data “with respect to” and not that the data is stored “with” the electronic property rights. Therefore, we find that the

examiner has not established a ***prima facie*** case of obviousness of the claimed invention, and we cannot sustain the rejection of independent claim 1 and its dependent claims. Similarly, we cannot sustain the rejections of independent claims 17 and 33 and their dependent claims for similar reasons.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-35 under 35 U.S.C. § 103 is REVERSED.

REVERSED


KENNETH W. HAIRSTON
Administrative Patent Judge

Jerry Smith
JERRY SMITH
Administrative Patent Judge


JOSEPH L. DIXON
Administrative Patent Judge

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